

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
(Attorney Docket No. 14309US02)**

In the Application of:

Jeyhan Karaoguz, et al.

Serial № 10/675,468

Filed: September 30, 2003

For: MEDIA PROCESSING SYSTEM
SUPPORTING PERSONAL
ADVERTISEMENT CHANNEL AND
ADVERTISEMENT INSERTION
INTO BROADCAST MEDIA

Examiner: Patrick A. Ryan

Group Art Unit: 2427

Confirmation № 5572

Electronically filed on October 25, 2010

REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief responds to the Examiner's Answer mailed on August 25, 2010. Claims 1-40 are pending in the present application. This Reply Brief is timely filed within the period for reply, which ends on October 25, 2010.

REMARKS

A. Independent Claims 1, 11 and 21

The Examiner states as follows regarding the rejection of claims 1, 11 and 21:

Appellant presents (Appeal Brief Pages 7-10) that the combination of Boston and Yen does not disclose or suggest the Claim 1 limitation of "automatically displaying, without user interaction prior to viewing said received advertisement, a notification of said received advertisement on said television; [and] scheduling, based on input from a user provided after said displaying of said notification, said received advertisement for viewing on said television within said home" because "Yen is silent with respect to notification of an advertisement and/or scheduling of an advertisement based on actions of a user with respect to the notification" (Appeal Brief bottom of Page 8). Appellant additionally presents that "the tags/guides [of Yen] merely note, for example, products that are advertised **on a broadcast show**, but **not** a notification of a received advertisement itself (as opposed to the broadcast show), **and certainly not scheduling of the received advertisement based on input from a user after display of the notification of the received advertisement**" (emphasis added by Appellant, Appeal Brief top of Page 10; with further reference to Yen Col. 7 Lines 41-55).

As previously presented in Final Office Action of November 23, 2009 ("Office Action") Page 4, Yen discloses that "foreground element 122 presents an indicator for the [information] item" (Col. 11 Lines 43-52), where an information item can indicate "which products are advertised or otherwise featured on a broadcast show or other information item" (Col. 7 Lines 29-39). In particular, Yen states that Foreground Element 122 is instructed to "...interrupt any ongoing presentation, or to enter an active mode for presentation, so as to bring the item to the attention of the recipient..." by presenting the "indicator for the item" (Col. 11 Lines 47-52). The Examiner notes that the claim does not particularly define the nature of "displaying... a notification" such that, in a broadest reasonable interpretation, any visual notice to the user would read on the claim. In the case of Yen, it is the Examiner's position

that an "indicator for the item", presented by Foreground Element 122, that "interrupt[s] any ongoing presentation" is an act of "displaying... a notification". Therefore, the Examiner submits that Yen's teaching of presenting an indicator for the information item sufficiently addressed the claimed "notification of a received advertisement."

(Answer, pp. 11-12 (emphasis in original.)) The Appellant disagrees with the Examiner's analysis. The Appellant notes, that claim 1 requires, *inter alia*, "**receiving the advertisement** for display on a television within a home . . . [and] automatically **displaying**, without user interaction and prior to viewing said received advertisement, a **notification of said received advertisement on said television.**" In context, the passage from column 7 that is cited by the Examiner reads as follows:

[T]he tag or electronic program guide can indicate the following types of information **about broadcast shows** and similar information items:

Subject matter for information items, such as whether those information items comprise news, weather, sports, politics, electronic mail, or opinion. The subject matter can include other particulars regarding the content of the information item, such as which persons are featured as actors, guests, or subjects **of a broadcast show** or other information item; **which products are advertised or otherwise featured on a broadcast show** or other information item; or which companies are producers or sponsors of a broadcast show or other information item.

(Yen, 7:26-39 (emphasis added.)) Nothing in these passages, or anywhere else in Yen, discloses or suggests "**receiving the advertisement** for display on a television within a home . . . [and] automatically **displaying**, without user interaction and prior to viewing said received advertisement, a **notification of said received advertisement on said television.**" Rather, Yen merely discloses tags/guides that provide information about

broadcast shows, including “which products are advertised or otherwise featured on a broadcast show.”

Next, the Examiner states as follows:

Additionally, the Examiner has presented, Office Action Page 4, that Yen discloses “the foreground element 122 can request confirmation from the recipient, and if confirmed, immediately begin displaying the information item” (Col. 11 Lines 29-32) or “the foreground element 122 can add the information item to a set of information items from which the foreground element 122 engages the recipient to select” (Col. 11 Lines 32- 35). The Examiner notes that the claim does not particular define the nature of “scheduling... said received advertisement for viewing” such that, in a broadest reasonable interpretation, any time-wise assignment of when viewing of the advertisement occurs would read on the claim. From the teachings of Yen, it is the Examiner’s position that immediately displaying the information item or deferring the display of the information item by adding the information item to a set of information items are teachings of “scheduling... said received advertisement for viewing.”

(Answer, pp. 12-14 (emphasis in original.)) The Examiner again blurs the distinction between tags/guides for broadcast shows (as disclosed by Yen) and “received advertisements,” as recited in the Appellant’s claims. In context, the cited passage from column 11 of Yen reads as follows:

When the background element 121 transmits the **information item** to the foreground element 122, the foreground element 122 may take one of several actions, in response to the recipient's preferences: (a) the foreground element 122 can immediately begin displaying the information item; (b) the foreground element 122 can request confirmation from the recipient, and if confirmed, immediately begin displaying the information item; (c) the foreground element 122 can add the information item to a set of information items from which the foreground element 122 engages the recipient to select; (d) the foreground element 122 can request confirmation from the recipient, and if confirmed, add the information item to the set of

information items from which the foreground element 122 engages the recipient to select; or (e) the foreground element 122 can take some other action to bring the information item to the attention of the recipient.

(Yen, 11:25-40 (emphasis added.)) Hence, this passage merely discloses that the “informational items” are transmitted to the foreground element where they are immediately displayed or added to the set of information items, which the foreground element 122 engages the recipient to select. However, nothing in this passage or anywhere else in Yen discloses or suggests that the informational item is a “received advertisement.” Rather, as noted above, the tags/guides relate to broadcast shows. Although Yen discloses that the tags/guides can provide information about **broadcast shows**, including “which products are advertised or otherwise featured on a broadcast show,” there is no disclosure, as is apparently alleged by the Examiner, that the “informational items” allow displaying or scheduling the display of a “received advertisement.”

According to the Examiner, “[f]rom the teachings of Yen, it is the Examiner’s position that immediately displaying the information item or deferring the display of the information item by adding the information item to a set of information items are teachings of ‘scheduling . . . said received advertisement for viewing.’” (Answer, p. 13.) The Appellant submits that this is an unreasonable and incorrect interpretation of Yen and of the claimed “scheduling.” Rather, the Appellant submits that, in the context of the claims, one of ordinary skill in the art would understand “scheduling” as setting a time (in the future), at which an event is to occur. This interpretation is consistent with the plain and ordinary meaning of the term “scheduling”. See, e.g., *Webster’s New*

International Dictionary (1993) ("Schedule: vt-ED/-ING/-S . . . to appoint, assign or designate to do or receive something at a fixed time in the future <*scheduled* [or scheduling] a meeting for next week>"); *see also The American Heritage Dictionary* 1228 (4th ed. 2000) (defining "scheduling" as "to plan or appoint for a certain time or date.") This construction is also supported by the specification of the present application, which describes scheduling in the context of adding an event to a time slot in a programming guide. (See, e.g., Application, ¶ 17, lines 5-6; *see also, id.*, ¶ 13, lines 5-7; *see also, id.*, ¶ 29, lines 5-7.) "Immediately displaying," as disclosed by Yen, simply is not the same as "scheduling," as recited in the claims. Obviously, if an item is "immediately displayed," there is no need to schedule the item for viewing, i.e., there is no need to set a time for viewing. Likewise, "[adding] the information item to a set of information items from which the foreground element 122 engages the recipient to select," as disclosed by Yen, does not reasonably constitute "scheduling," at least because it does not involve setting a time for viewing/displaying the informational item.

The Examiner also states as follows with regard to the rejection of the independent claims:

Appellant appears to argue that because Yen's "information item" includes subject matter such as "which products are advertised or otherwise features on a broadcast show or other information items" it does not address the limitations of Claim 1 because the "information item" is "of a broadcast show" and not is not related to the advertisement itself (Appeal Brief bottom of Page 9 and top of Page 10; with further reference to Yen Col. 7 Lines 25-39). The Examiner notes that the claim does not particular define the nature of an "advertisement" and only requires, for example, "...providing an advertisement in a communication channel... for display on a television within a home", such that, in a broadest reasonable interpretation, an "advertisement" could

include any advertising information provided and displayed to the user.

It is therefore the Examiner's position that the combination of Boston and Yen teach "automatically displaying, without user interaction and prior to viewing said received advertisement, a notification of said received advertisement on said television; [and] scheduling, based on input from a user provided after said displaying of said notification, said received advertisement for viewing on said television within said home" as recited in Claim 1 and similarly Claims 11 and 21.

(Answer, pp. 13-14.) Once again, the Examiner is improperly blurring the distinction between an informational item about a broadcast show (as disclosed by Yen) and a "received advertisement" (as recited in the claims). Yen merely discloses tags/guides that provide information about **broadcast shows**, including "which products are advertised or otherwise featured on a broadcast show." Yen, however, fails to disclose or suggest "**receiving the advertisement** for display on a television within a home . . . [and] automatically **displaying**, without user interaction and prior to viewing said received advertisement, a **notification of said received advertisement on said television.**"

Accordingly, for at least the reasons set forth above and in the Appeal Brief, the Appellant submits that independent claims 1, 11 and 21 are patentable over the proposed combination of Boston and Yen.

B. Claims 6, 16 and 26

The Examiner states as follows regarding the rejection of claims 6, 16 and 26:

Appellant further presents (Appeal Brief Pages 13-16) that the combination of Boston and Yen does not disclose or suggest the Claim 6 limitation of "identifying a gap that exists in a schedule in a channel guide displayed on said

television" because nothing in the cited passages of Boston disclose or suggest the limitation (Appeal Brief bottom of Page 15; with further reference to Boston 001.8 Line 52-001.9 Line 16 and Col. 12 Lines 4-32).

The Examiner has previously presented (Office Action Page 6) that Boston teaches the limitations of Claim 6, in part, by way of the method of Figure 8 (as described in Col. 8 Line 52—Col. 9 Line 27). In particular, Boston discloses that a decision is made at Step 835 if a commercial break is scheduled (Col. 8 Line 62—Col. 9 Line 3). As presented in the discussion of Claim 2, Boston uses an "Edit Schedule" to determine when or if a commercial can be inserted during the commercial breaks. For example, Boston discloses that "Edit Schedule 815 corresponding to the selected program and including commercial breaks is retrieved (Step 810)" (as described in Col. 8 lines 52-57) and used to determine when or if targeted commercials can be inserted during the commercial breaks (as described in Col. 8 Line 58-col. 9 Line 27). It is the Examiner's position that Boston's determination of "commercial breaks" is analogous to the claimed "identifying a gap that exists in a schedule in a channel guide". With reference to Figure 10, Boston further teaches a method including a determination of "when a commercial break is scheduled" (at Step 1035) and, during a break, a commercial is played or recorded (at Step 1050) (as described in Col. 10 Lines 22-67).

It is therefore the Examiner's position that the combination of Boston and Yen teach "identifying a gap that exists in a schedule in a channel guide displayed on said television" as recited in Claim 6 and similarly Claims 16 and 26.

(Answer, pp. 16-17.) Hence, the Examiner apparently alleges that the edit schedule 815 discussed in connection with Figure 8 constitutes the "channel guide" recited in claims 6, 16 and 26. The Appellant respectfully disagrees. Claim 6 requires "identifying a gap that exists in a schedule **in a channel guide displayed on said television.**" Claims 16 and 26 include similar limitations. Boston provides the following description of Figure 8:

FIG. 8 is a flowchart for **DVR processing of custom commercials**. **DVR client processing commences at 800** whereupon a program is selected to be played or recorded (step 805). **Edit schedule 815 corresponding to the selected program and including commercial breaks is retrieved** (step 810).

At the start time of the selected program, program content 830 is received and recorded (step 820) from content provider 825, such as a cable television service provider, a satellite service, or the like. A timer is set to determine when the program is over (decision 885). If the program is over, decision 885 branches to "yes" branch 890 and processing ends at 895. On the other hand, until the program is over, decision 885 branches to "no" branch 888 whereupon another timer is set for the next scheduled commercial break during the program (decision 835). If it is not time for a commercial break, decision 835 branches to "no" branch 835 which loops back to continue receiving and recording content received from the content provider.

On the other hand, **if it is time for a commercial break**, decision 835 branches to "yes" branch 838 **whereupon commercial metadata 845 is compared with information about the client's interests and preferences from client profile 850 as well as metadata describing the current program 855. A commercial is selected based on the comparison (step 840). The selected commercial is retrieved from commercial and recorded or played for the user (step 860).** A counter is incremented for the selected commercial in order to keep track of the number of times the commercial was recorded or played (step 870). The counter information is stored in data store 875 so that it can be eventually sent to the DVR service provider for analysis and reporting.

A determination is made as to whether there is enough time left in the commercial break to record or play another commercial (decision 880). If there is enough time, decision 880 branches to "yes" branch 882 whereupon another commercial is selected and played or recorded. This continues until the commercial break is over, at which time decision 880 branches to "no" branch 884 which loops back to continue receiving content from the

content provider. When the program is over, decision 885 branches to "yes" branch 890 and processing ends at 895.

(Boston, 8:52-9:26.) Nothing in this passage discloses or suggests that the edit schedule 815 (the alleged channel guide) is displayed on a television or otherwise. Rather, Figure 8 describes "DVR processing of custom commercials," where the DVR uses the edit schedule to play or record commercials during commercial breaks.

The Examiner also relies as follows on Figure 10 of Boston in maintaining the rejection of claims 6, 16 and 26. (Answer, p. 17.) Boston describes Figure 10 as follows:

FIG. 10 is a flowchart for a DVR client processing downloaded commercials that are referenced in a customized edit schedule. DVR client processing commences at 1000 whereupon a program is selected for viewing or recording on the DVR (step 1005). **Edit schedule 1015 corresponding to the selected program is retrieved at step 1010. When the program begins, the DVR receives content 1030 from content provider 1025, such as a cable television service provider, a satellite service, or the like at step 1020.**

A timer is set to determine when the program ends (decision 1085). When the program ends, decision 1085 branches to "yes" branch 1090 and processing of the program ends at 1095. On the other hand, until the program is over, a timer is set to the next commercial break (decision 1035). Until the time of the next commercial break, decision 1035 branches to "no" branch 1036 and continues receiving the program content. When a commercial break is scheduled, decision 1035 branches to "yes" branch 1038 whereupon the edit schedule is read to determine whether the first commercial identifier for the commercial break is a custom identifier (decision 1040).

If the identifier is a custom identifier, decision 1040 branches to "yes" branch 1042 whereupon the commercial identifier is retrieved (step 1045), the commercial corresponding to the identifier is retrieved from data store 1055 and played or

recorded at step 1050. The play count corresponding to the retrieved commercial is incremented (step 1060) and stored in commercial play counter data store 1065. The commercial play counter data is eventually sent to the DVR service provider for analysis and for preparing reports to advertisers. On the other hand, if the commercial identifier is not a custom identifier, decision 1040 branches to "no" branch 1068 whereupon the commercial sent from the content provider is received and played or recorded at step 1070.

A determination is made as to whether there are more commercials to play during the commercial break (decision 1075). If there are more commercials, decision 1075 branches to "yes" branch 1078 whereupon the next commercial identifier is selected (step 1080) and processing loops back to record or play the next commercial. This looping continues until the commercial break is over at which time decision 1075 branches to "no" branch 1082 which loops back to continue receiving and playing or recording program content. When the program is over, decision 1085 branches to "yes" branch 1090 whereupon processing of the selected program ends at 1095.

(Boston, 10:22-11:2.) As with Figure 8, there is no indication that the edit schedule 1015 of Figure 10 is displayed on a television or otherwise. Rather, Figure 10 describes how a DVR uses an edit schedule to where the DVR uses the edit schedule to play or record commercials during commercial breaks.

Hence, the Appellant maintains that claims 6, 16 and 26 are patentable at least because that the proposed combination of Boston and Yen does not disclose or suggest at least the limitation of "identifying a gap that exists in a schedule in a **channel guide displayed on said television.**"

Accordingly, for at least the reasons set forth above and in the Appeal Brief, the Appellant submits that independent claims 6, 16 and 26 are patentable over the proposed combination of Boston and Yen.

C. Claims 7, 17 and 27

The Examiner states as follows regarding the rejection of claims 7, 17 and 27:

Appellant presents (Appeal Brief Page 16) that the combination of Boston and Yen does not disclose or suggest the Claim 7 limitation of "scheduling at least one advertisement for display at a time corresponding to said identified gap" because "Boston does not 'identify a gap' (see above re claim 6)..." It is the Examiner's position that Boston does "identify a gap" (as addressed above with respect to Claim 6) and therefore submits that the combination of Boston and Yen teaches the limitations of Claim 7 and similarly Claims 17 and 27.

(Answer, p. 17.)

Claims 7, 17 and 27 depend respectively on claims 6, 16 and 26. Therefore, the Appellant maintains that these claims are allowable for at least the reasons given above in connection with claims 6, 16 and 26.

Accordingly, for at least the reasons set forth above and in the Appeal Brief, the Appellant submits that independent claims 7, 17 and 27 are patentable over the proposed combination of Boston and Yen.

D. Claims 8, 18 and 28

The Examiner states as follows regarding the rejection of claims 8, 18 and 28:

Appellant presents (Appeal Brief Pages 16-19) that the combination of Boston and Yen does not disclose or suggest the Claim 7 [(sic. Claim 8)] limitation of "granting permission to schedule said at least one advertisement for display within said identified [gap]" because "[a]gain, as with claim 6, nothing in the cited passages of Boston discloses or suggests 'identifying a gap that exists in a schedule in a channel guide displayed on said television.'" It is the Examiner's position that Boston does "identify a gap" (as addressed above with respect to Claim 6) and therefore

submits that the combination of Boston and Yen teaches the limitations of Claim 8 and similarly Claims 18 and 28.

(Answer, p. 18.)

Claims 8, 18 and 28 depend respectively on claims 6, 16 and 26. Therefore, claims 8, 18 and 28 are allowable over the proposed combination of Boston and Yen at least for the reasons stated above with regard to claims 6, 16 and 26.

Accordingly, for at least the reasons set forth above and in the Appeal Brief, the Appellant submits that independent claims 8, 18 and 28 are patentable over the proposed combination of Boston and Yen.

E. Claims 9-10, 19-20 and 29-30

The Examiner states as follows regarding the rejection of claims 9-10, 19-20 and 29-30:

Appellant presents (Appeal Brief Pages 19-21) that the combination of Boston, Yen, and Oh does not disclose or suggest "offering a reward for scheduling the advertisement for display within a personal advertisement channel displayed on said television" (as recited by the Appellants in claims 9-10 and 19-20) nor "wherein said at least one processor offers a reward for scheduling the advertisement for display within a personal advertisement channel displayed on said television" (as recited by the Appellants in claims 29-30) because "the cited portion of Oh merely discloses incentives for watching, as opposed to scheduling in a personal advertisement channel, advertisement content" (Appeal Brief Pages 19-20; with further reference to Oh Paragraph [00541]).

The Examiner has previously presented (Office Action Pages 7-8) that Oh demonstrates "a reward method of providing advertisement content to a user in which multimedia content prices are discounted in an incremental fashion dependent upon when the user elects to view the given advertisement" and "if the user elects to view the

advertisement while the multimedia content is being played, the system provides the said multimedia content for free". In particular, Oh allows a user to choose when to view advertisement content, such as "before the multimedia content(s) is(are) played" or "while the multimedia content(s) is(are) being played" or "after the multimedia content(s) is(are) played" and discounts the price of the multimedia content based on the user's choice (Paragraph [00541]). The Examiner again notes that (in a similar fashion to Claim 1) the claim does not particular define the nature of "...scheduling the advertisement for display..." such that, in a broadest reasonable interpretation, any time-wise assignment of when viewing of the advertisement occurs would read on the claim. It is the Examiner's position that a user's selection of viewing advertisements "before", "while", or "after" the multimedia content is presented are acts of scheduling the advertisements and discounting the price of the multimedia, when one of these options is selected by the user, is an act of rewarding. The Examiner additionally notes that Oh, in a similar fashion to Boston (Col. 5 Lines 35-67 and Col. 6 Lines 1-54), discloses retrieving advertisements based on "user information" (as disclosed in Paragraph [00451]).

It is therefore the Examiner's position that the combination of Boston, Yen, and Oh teach the limitations recited in Claims 9-10 and similarly Claims 19-20 and 29-30.

(Answer, pp. 19-20.) The Appellant respectfully maintains that claims 9-10, 19-20 and 29-30 are patentable over the proposed combination of Boston, Yen, and Oh. Once again, the Examiner ignores explicit claim language when rejecting the claims. Specifically, claims 9-10 and 19-20 require "offering a reward for **scheduling the advertisement for display within a personal advertisement channel displayed on said television.**" Similarly, claims 29-30 require "wherein said at least one processor offers a reward for **scheduling the advertisement for display within a personal advertisement channel displayed on said television.**" None of the cited references appear to disclose or suggest "a personal advertisement channel," as required by the

claims. Nor has the Examiner explained how this claim limitation is allegedly disclosed in the cited references.

Accordingly, for at least the reasons set forth above and in the Appeal Brief, the Appellant submits that claims 9-10, 19-20 and 29-30 are patentable over the proposed combination of Boston, Yen, and Oh.

CONCLUSION

For at least the foregoing reasons, the Appellant submits that claims 1-40 are in condition for allowance. Reversal of the Examiner's rejection and issuance of a patent on the application are therefore requested.

The Commissioner is hereby authorized to charge any fees or credit any overpayment in connection with this filing to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Date: October 25, 2010

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